

Appl. No. : 09/915,495  
Filed : July 26, 2001

## REMARKS

### A. Introduction

Applicant respectfully requests reconsideration and allowance of this application. Claims 1-20 are pending in the application. Applicant has amended Claim 1 to further clarify Applicant's claimed invention. Applicant submits that this application, as amended, is in condition for allowance, and Applicant earnestly requests such action. Below, Applicant addresses each of the Examiner's reasons for rejection.

### B. Election/Restriction

In response to the restriction requirement, Applicants elect Invention I (Claims 1-9) for prosecution in the present application.

Applicants make the present election with traverse. The non-elected Group is directed to a method of forming a flashing member and a method of flashing a recessed window. The elected Group is drawn to a corner flashing system. Thus, a proper search for art related to the elected Group would necessarily include the classes and subclasses relevant to a search for the non-elected Group. Thus, examination of all the claims would not present "a serious burden on the Examiner." M.P.E.P. § 803. Applicants therefore respectfully request that the present restriction requirement be withdrawn.

### C. All Claims are Patentable Over the Cited References

#### Mayle - § 102 Rejections

The Examiner rejected Claim 1 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,706,610 to Mayle. Applicant respectfully submits that this claim, as amended, is allowable over Mayle.

An anticipation rejection under § 102 requires that "every element of the claimed invention must be identically shown in a single reference." *In re Bond*, 910 F.2d 831 (Fed. Cir. 1990). "There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention." *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565 (Fed. Cir. 1991).

Various preferred embodiments of the present application define, *inter alia*, a corner flashing system for use in recessed window frames. The flashing system prevents moisture from penetrating corners of the frame. The flashing system comprises a window frame and a first member having horizontal and vertical seating flanges. The seating flanges are joined to one

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another at a 90° angle along a first edge. The flanges seat respectively on a horizontal surface and a vertical surface of the window frame. The first member further comprises a first flap extending at a 90° angle from a second edge of the vertical flange. The first member further comprises a second flap extending at a 90° angle from a second edge of the horizontal flange. The first and second flaps lie in the same plane and engage a vertical wall of the window frame.

By contrast, Mayle discloses a universal fitment for use with polymer-coated roof membranes. The fitment covers areas on and around vertical protrusions in a roof. The fitment has a body with preferably three sides, a tab, and a neck connecting a corner of the body to the tab. The body is preferably either substantially square or substantially triangular. Mayle also discloses a universal boot. The boot has a generally rectangular section with a split extending vertically in a side, and a fitment with a body having at least three sides, a tab, and a neck connecting a corner of the body to the tab. The tab of the fitment is preferably welded to the back of the rectangular section above the split.

Mayle does not disclose a corner flashing system for use in recessed window frames. The fitment and the boot disclosed in Mayle are adapted to cover areas on and around vertical protrusions in a roof. Mayle does not teach the use of the fitment or the boot in recessed window frames. Mayle thus does not identically disclose every element of Applicant's claimed invention. Accordingly, Mayle does not anticipate Applicant's claimed invention.

Since Mayle does not disclose a corner flashing system for use in recessed window frames, Applicant respectfully submits that Mayle does not anticipate independent Claim 1, as amended. Accordingly, Applicant respectfully requests that the Examiner withdraw this rejection.

#### Mayle - § 103 Rejections

The Examiner rejected Claims 2, 3, 7 and 8 under 35 U.S.C. § 103(a) as being unpatentable over Mayle. Applicant respectfully submits that these claims are allowable over Mayle.

In rejecting claims under § 103, the Examiner bears the initial burden of presenting a *prima facie* case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). To establish a *prima facie* case of obviousness, the following criteria must be met. There must be some suggestion or motivation found in the prior art, either in one or more references or in the knowledge generally available to one of ordinary skill in the art, to modify a prior art reference or

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to combine reference teachings to meet the limitations of the claim. Further, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991); M.P.E.P. § 706.02(j). "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. & Inter. 1985); M.P.E.P. § 706.02(j).

As described above, Mayle does not disclose a corner flashing system for use in recessed window frames. The Examiner has asserted that it would have been obvious to one of skill in the art to have modified Mayle to arrive at Applicant's claimed invention. Applicant respectfully disagrees. Mayle does not even suggest using the fitment or the boot in recessed window frames. Furthermore, it is doubtful that one skilled in the building and construction arts would look to Mayle in attempting to solve the problem of leaks around recessed window frames. Mayle teaches a device and method for sealing the area around a protrusion in a roof. Materials commonly used in roofing are not compatible with materials commonly used in window flashing, as those of skill in the art are well aware. Adverse chemical reactions between these two categories of materials destroy the sealing capabilities of the materials. Therefore, one of skill in the art would not have looked to a reference that pertains to roofing, such as Mayle, in order to create a system for preventing leaks around recessed window frames.

Since Mayle does not disclose or suggest a corner flashing system for use in recessed window frames, Applicant respectfully submits that Claims 2, 3, 7 and 8 are not unpatentable over Mayle. Accordingly, Applicant respectfully requests that the Examiner withdraw these rejections.

### CONCLUSION

For the reasons presented above, Applicant respectfully submits that this application, as amended, is in condition for allowance. If there is any further hindrance to allowance of the pending claims, Applicant invites the Examiner to contact the undersigned.


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Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

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By:   
Scott Loras Murray  
Registration No. 53,360  
Attorney of Record  
Customer No. 20,995  
(949) 760-0404

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